

REMARKS

The statement by the Examiner that claims 20, 22, 31 and 34 contain allowable subject matter is gratefully acknowledged.

Claims 19, 29, and 39-44 have been amended. Claims 19-44 are pending in the present application. Applicant reserves the right to pursue the original claims and other claims in this application and in other applications.

Claims 43 and 44 stand rejected under 35 U.S.C. § 112, first paragraph. According to the Office Action, there is no language in the specification which specifically teaches or suggests that the claimed features are implemented by software. The rejection is respectfully traversed and reconsideration is respectfully requested.

Applicants respectfully wish to draw the Examiner's attention to page 9, line 19 to page 11, line 17 of the present specification. This portion of the specification discloses executing merge and route routines, such as the ones claimed in claims 43 and 44, via software instructions executed by a CPU 42. For example, the specification states that "[t]he merge and route routine 100 of FIG. 6 is stored by storage device 74. In the alternative, merge and route routine 100 may be stored in ROM 50, DRAM 46, or EEPROM 48. Regardless of where the merge and route routine 100 is stored, CPU 42 executes the appropriate instructions corresponding to the routine. Thus, the merge request block 102 of FIG. 6 invokes the merge and route routine 100." This language, among other similar language found between page 9, line 19 to page 11, line 17, clearly establishes that the claimed invention may be implemented in software and stored on a computer readable storage medium. As such, this disclosure adequately enables one of skill in the art to implement the claim 43 and 44 inventions.

Accordingly, Applicant respectfully submits that the rejection should be withdrawn and the claims allowed.

Claims 19, 21, 23-30, 32, 33 and 35-44 stand rejected under 35 U.S.C. § 103(a) as being anticipated by Kobori in view of Tuttle. The rejection is respectfully traversed and reconsideration is respectfully requested.

Claim 19 recites an image handling apparatus. That apparatus includes, among other things, “a plurality of input interfaces for inputting image data; a first selector for selecting one of said input interfaces for providing a first image data; a storage device for storing a plurality of stored images; a second selector for selecting as a second image data one of said plurality of stored images based on a user input stored image selection; a device for combining said first image data and said second image data to produce a third image data; and a third selector for selecting one of a plurality of receiving devices to receive said third image data.” Applicant respectfully submits that the cited combination fails to disclose the claimed invention.

As argued previously, Kobori discloses a video printer system that is capable of printing stored digital signals on separate areas of a page. This way, multiple images can be printed on the same page. Kobori also discloses a video printer that receives plural input images from cameras 1, 27. The analog video images received from the cameras 1, 27 are combined in the analog domain by a combining circuit 4, converted into digital form by an analog-to-digital converter 8, and combined (by circuit 9) with digital data from a personal computer 7. The combined digital data is provided to a memory system comprising plural memories. Access to the plural memories are controlled by switches 28, 151, 152, 153, and 154 such that one memory may be used to drive one of plural output devices while another memory may be accessed by the circuit 9. Each memory may be selectively coupled to one of the plural output devices,

which include a digital-to-analog converter 14 for driving a monitor 15 and a line memory 19, which operates with a half tone circuit 18 to drive a printer 17.

In Kobori, the combining circuit 4 combines analog RGB data from both cameras 1 and 27. *See, e.g.*, Fig. 11. Accordingly, Kobori fails to disclose or suggest any mechanism for “selecting as a second image data one of said plurality of stored images based on a user input stored image selection” as recited in claim 19. This claim feature, among others, is simply not found in Kobori. This fact is acknowledged by the Office Action, which attempts to combine Kobori with Tuttle to overcome the deficiencies of Kobori. The Office Action states that Tuttle teaches “a host computer 122 which has input means 110 for inputting data thereto from a human. Thus the input means 122 serves as a user based input selection.” The Office Action states that the combination is proper because “Kobori and Tuttle are both in the art of image handling, the purpose of allowing a user to input selection data would have been contemplated by Kobori as set forth by Tuttle.” Applicant respectfully disagrees with both of these arguments.

Initially, Applicant notes that the two references are not properly combinable. Kobori relates to a video printer system that is capable of printing stored digital signals on separate areas of a page, but Tuttle relates to a system for testing computer hardware. Both patents are not related to image handling. One would not be motivated to modify the Kobori apparatus with anything in the Tuttle reference. Accordingly, Applicant respectfully submits that there is no motivation for combining the teachings of Kobori with Tuttle to achieve the claimed invention.

Moreover, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Simply providing a reference (i.e., Tuttle) disclosing an alleged “input means” does not signify

that there is a motivation to combine that reference with Kobori's apparatus to render the claimed invention obvious.

In any event, claim 19 has been amended to specifically recite that the selection of the second image data is based "on a user input stored image selection." That is, according to claim 19, the user input is a selection of a stored image from a plurality of stored images. The Tuttle "input means" is not for selecting between stored images and does not correspond to the claimed invention. Accordingly, Applicant respectfully submits that claim 19 is allowable over the cited combination.

Claims 21 and 23-28 depend from claim 19 and are allowable along with claim 19 for at least the reasons set forth above and on their own merits.

Claim 29 recites an image handling method. According to claim 29, the method comprises "first selecting one of a plurality of input interfaces for receiving a first image data; second selecting one of a plurality of stored images as a second image data based on a user input stored image selection; combining said first image data and said second image data to produce a third image data; and third selecting one of a plurality of receiving devices to receive said third image data."

As set forth above, the cited combination fails to disclose, teach or suggest any mechanism for "selecting one of a plurality of stored images as a second image data based on a user input stored image selection" as recited in claim 29. Accordingly, Applicant respectfully submits that claim 29 is allowable over the cited combination. Claims 30, 32, 33 and 35-38 depend from claim 29 and are allowable along with claim 29 for at least the reasons set forth above and on their own merits.

Claims 39-44 recite similar limitations as the ones discussed above.

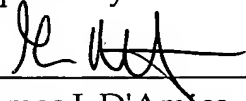
Accordingly, Applicant respectfully submits that claims 39-44 are allowable over the cited combination for at least the reasons set forth above and on their own merits.

Applicant respectfully submits that the rejection should be withdrawn and claims 19, 21, 23-30, 32, 33 and 35-44 allowed.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

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